



COPY OF PAPERS  
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Attorney Docket No. 237.US  
**PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kim et al.

Serial No.: 09/555,442

Group No.: 1626

Filed: May 31, 2000

Examiner: S. Wright

For: Cyclohexene Carboxylates as Neuraminidase Inhibitors

**RECEIVED**

JUN 11 2002

TECH CENTER 1600/2900

Assistant Commissioner for Patents  
Washington, D.C. 20231

**AMENDMENT TRANSMITTAL**

1. Transmitted herewith is an amendment for this application.

**STATUS**

2. Applicant is

☐ a small entity - verified statement:

☐ attached.

☐ already filed.

☒ other than a small entity.

**CERTIFICATE OF MAILING (37 CFR 1.8 (a))**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: May 20, 2002

Vicki Collins

(Type or print name of person mailing paper)

Vicki Collins  
(Signature of person mailing paper)

### EXTENSION OF TERM

3. The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply

- (a) ☒ Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17 (a)-(d)) for the total number of months checked below:

	<u>Extension (months)</u>	<u>Fee for other than small entity</u>	<u>Fee for small entity</u>
<input type="checkbox"/>	one month	\$110.00	\$55.00
<input type="checkbox"/>	two months	\$400.00	\$200.00
<input checked="" type="checkbox"/>	three months	\$920.00	\$460.00
<input type="checkbox"/>	four months	\$1,440.00	\$720.00
		Fee \$	<u>920.00</u>

**If an additional extension of time is required please consider this a petition therefor.**

- ☐ An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ 920.00

**OR**

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

# FEE FOR CLAIMS

4. The fee for claims (37 CFR 1.16(b)-(d)) has been calculated as shown below:

4. THE 100 TOP CLAIMS (5% OF TOTAL PATENT APPLICATIONS) (5% OF ALL PATENT APPLICATIONS)									
(Col. 1)			(Col. 2)	(Col. 3)	SMALL ENTITY			OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE	OR	RATE	ADDIT. FEE
TOTAL *	1	MINUS **	42	= 0	X 9 =	\$		X18=	\$ 0
INDEP. *	1	MINUS **	7	= 0	X42=	\$		X84=	\$ 0
<input type="checkbox"/>	FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				+140=	\$		+280=	\$ 0

TOTAL  
ADDIT. FEE \$

OR TOTAL  
ADDIT.  
FEE \$

(c) ☒ No additional fee for claims is required.

OR

(d) ☐ Total additional fee for claims required \$ \_\_\_\_\_

## FEE PAYMENT

5. ☐ Attached is a check in the sum of \$ \_\_\_\_\_

☒ Charge Account No. 07-1250 the sum of \$ 920.00

A duplicate of this request is attached.

## FEE DEFICIENCY

6. Authorization to Charge Additional Fees

☒ The Commissioner is hereby authorized by this document to charge any additional fees which may be required by this paper and during the entire pendency of this application to Account No. 07-1250, except the issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR 1.311 (b).

Reg. No. 35,071

Tel. No.: (650) 522-5569

Mark L. Bosse  
SIGNATURE OF ATTORNEY

Mark L. Bosse

Type or print name of attorney

Gilead Sciences, Inc.

333 Lakeside Drive

P.O. Address

Foster City, CA 94404

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for patents, Washington, D.C. 20231.

Vicki Collins

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PATENT

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In re PATENT APPLICATION of

Kim et al

Serial No: 09/555,442

Filed: May 31, 2000

Title: Cyclohexene Carboxylates as  
Neuraminidase Inhibitors



) Group Art Unit: 1626  
) Attorney Docket No. 237.US  
) Examiner: Wright, S.  
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AMENDMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

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Dear Sir:

This is responsive to the Patent and Trademark Office action mailed 19 November 2001. A request for a THREE MONTH extension of time is submitted herewith, whereby the time for response expires on 19 May 2002.

Amendment

Please amend the abstract to be identical to present Claim 35.

Remarks

Applicants request reconsideration of the present application in view of the amendment above and the remarks that follow.

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### Objections

The Office has objected to the Abstract. Applicants have amended the Abstract to be identical with present Claim 35.

### Rejection Under 35 U.S.C. § 102

The Office has rejected Claim 35 under 35 U.S.C. § 102 in view of the Bischofberger reference because, argues the Office, Bischofberger teaches the same compounds.

Applicants respectfully disagree. The Bischofberger compounds are methyl esters. The present compounds are ethyl esters.

### Rejection Under 35 U.S.C. § 103

The Office has rejected Claim 35 under 35 U.S.C. § 103 in view of Bischofberger reference because, argues the Office, the present compounds differ by a methyl group. Applicants respectfully traverse the rejection.

The Bischofberger compounds are methyl esters and the present compounds are ethyl esters. They are intermediates for the synthesis of two different pharmaceutical compositions. Each pharmaceutical is administered to an animal. The ester portion of the compound is cleaved to form an active carbocyclic acid in the animal.

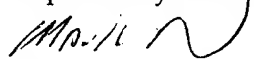
The function of the ester portion of the molecule is to provide for oral bioavailability of the parent drug, in this case a carboxylic acid. The Office has argued that the similarity of structure is sufficient to provide knowledge of the properties of the two products.

Applicants respectfully suggest that the Office has not identified a reference which motivates the selection of ethyl among all the possible ester or other prodrugs for the active carboxylic acid. In the absence of such a reference, the Office is asserting that what is obvious from the perspective of an organic chemist looking at physical properties, is also obvious for a medicinal chemist looking at bioavailability.

Request for a Telephonic Interview

If the Examiner deems it useful, Applicants request, at the Examiner's convenience, a telephonic interview with the undersigned for the purpose of expediting the allowance of the present Application.

Respectfully submitted,



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Dated: May 20, 2002